IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	Cheryl L. Galante, et. al	Group Art Unit: 1617
Serial No.:	09/784,488	Examiner: Layla Soroush
Filed:	02/15/2001	Confirmation No.: 1716

For: PERSONAL CARE PRODUCT

Docket No.: 7144

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Board of Patent Appeals and Interferences
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits its Appeal Brief in response to the final rejection of the subject patent application.

The Commissioner is hereby authorized to charge The Dial Corporation Deposit Account No. 50-4219, $540 for the filing of this Appeal Brief.

TABLE OF CONTENTS

I. INTRODUCTION

This is an Appeal Brief under 37 C.F.R. § 41.37 appealing the rejections set forth in the final Office action dated June 25, 2008. Each of the topics required by 37 C.F.R. § 41.37 is presented in this Brief and is labeled appropriately.

II. REAL PARTY IN INTEREST

The Dial Corporation ("Dial") is the real party in interest of the present application. An assignment of all rights in the present application to The Dial Corporation was executed by the assignor, The Gillette Company, recorded by the U.S. Patent and Trademark Office at **Reel** 019028**, Frame** 0775.

III. RELATED APPEALS OR INTERFERENCES

There are no appeals or interferences related to the present application of which Appellant is aware.

IV. STATUS OF CLAIMS

Claims 1, 5, 7-9, 11, 13, 16, 20, 21, 61, 63, 66, and 67, which are presented in the Claims Appendix, are pending in the application. Claims 1, 5, 7-9, 11, 13, 16, 20, 21, 61, 63, 66, and 67 stand finally rejected. Accordingly, the Appellant hereby appeals the final rejection of Claims 1, 5, 7-9, 11, 13, 16, 20, 21, 61, 63, 66, and 67.

V. STATUS OF AMENDMENTS

Following a final Office action, dated June 25, 2008, Appellant filed a Notice of Appeal on September 11, 2008.

No amendment has been filed following the Notice of Appeal.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

Generally speaking, Applicant's invention is an underarm antiperspirant product with container and a composition cast therein, where the composition has physically distinct portions, and where each of the portions minimally includes at least one volatile silicone, a wax, or both.

Claim 1:

Specifically, what Applicant claimed in independent Claim 1 is an underarm antiperspirant product including an application surface that contacts the underarm during use of the product, (Page 4, Lines 25-27; Figure 1, application surface **14**). The product also comprises a container, (Page 4, Line 25; Figure 1, container **12**), to hold an antiperspirant composition having two physically and chemically distinct portions, (Page 4, Lines 28-30; Figures 1-2, separate portions **16** and **18**). For clarity, the two portions are delineated as first portion and second portion having different compositions, (Page 5, Lines 7-10), and both of these portions include a suspended antiperspirant salt, (Page 5, Lines 23-24; Page 5, Line 26 through Page 7, Line 22 for specific antiperspirant actives). Each portion is comprised of an anhydrous and hydrophobic vehicle, (Page 5, Line 24), and each includes at least a volatile silicone, or a wax, or both, (Page 5, Lines 24-25; Page 8, Lines 21-31). If one of the portions includes a wax, then the wax is further limited by having a melting temperature of at least 70°C, (Page 8, Lines 11-16). Both the first and second portions are firm enough to support one another in the container, (Page 2, Lines 6-7; Figures 1-2 with first and second portions **16** and **18**, where portion **18** is molded in as central portion running down through the length of the product, forming a

"stripe" that is visible across the exposed application surface **14**). These specific elements are also set forth in appealed independent Claim 1.

Claim 9:

What Applicant has claimed in independent Claim 9 is another embodiment of the two portioned antiperspirant product where the portions are claimed to be different in color.

In Claim 9, Applicant claims an underarm antiperspirant product including an application surface that contacts the underarm during use of the product, (Page 4, Lines 25-27; Figure 1, application surface **14**). The product also comprises a container, (Page 4, Line 25; Figure 1, container **12**), to hold an antiperspirant composition having two physically and chemically distinct portions, (Page 4, Lines 28-30; Figures 1-2, separate portions **16** and **18**) that are visibly distinct due to their different colors, (Page 2, Lines 8-13; Page 5, Lines 1-3; Page 13, Lines 24-25). For clarity, the two portions are delineated as first portion and second portion having different compositions, (Page 5, Lines 7-10), and both of these portions include a suspended antiperspirant salt, (Page 5, Lines 23-24; Page 5, Line 26 through Page 7, Line 22 for specific antiperspirant actives). Each portion is comprised of an anhydrous and hydrophobic vehicle, (Page 5, Line 24), and each includes at least a volatile silicone, or a wax, or both, (Page 5, Lines 24-25; Page 8, Lines 21-31). If one of the portions includes a wax, then the wax is further limited by having a melting temperature of at least 70°C. (Page 8, Lines 11-16). Both the first and second portions are firm enough to support one another in the container, (Page 2, Lines 6-7; Figures 1-2 with first and second portions **16** and **18**, where portion **18** is molded in as central portion running down through the length of the product, forming a "stripe" that is

visible across the exposed application surface **14**). These specific elements are also set forth in appealed independent Claim 9.

Claim 16:

Lastly, what Applicant has claimed in independent Claim 16 is another embodiment of the two portioned antiperspirant product where the portions are different in color and different in their levels of antiperspirant salt.

In Claim 16, Applicant claims an underarm antiperspirant product including an application surface that contacts the underarm during use of the product, (Page 4, Lines 25-27; Figure 1, application surface **14**). The product also comprises a container, (Page 4, Line 25; Figure 1, container **12**), to hold an antiperspirant composition having two physically and chemically distinct portions, (Page 4, Lines 28-30; Figures 1-2, separate portions **16** and **18**) that are visibly distinct due to their different colors, (Page 2, Lines 8-13; Page 5, Lines 1-3; Page 13, Lines 24-25). For clarity, the two portions are delineated as first portion and second portion having different compositions, (Page 5, Lines 7-10), and both of these portions include a suspended antiperspirant salt, (Page 5, Lines 23-24; Page 5, Line 26 through Page 7, Line 22 for specific antiperspirant actives). The first portion includes more than 6 USP weight percent of an antiperspirant salt, (support for amount: Page 8, Lines 4-6; support for calculation of USP wt. %: Page 4, Lines 28-30 continuing through Page 5, Lines 1-3). The second portion includes less than 6 USP weight percent of an antiperspirant salt, (support for amount: Page 4, Lines 6-7; support for calculation of USP wt. %: Page 4, Lines 28-30 continuing through Page 5, Lines 1-3). Each portion is comprised of an anhydrous and hydrophobic vehicle, (Page 5, Line 24), and each includes at least a volatile silicone, or a wax, or both, (Page 5, Lines 24-25; Page 8, Lines 21-31). If one of the portions includes a wax, then the wax is further

limited by having a melting temperature of at least 70ºC. (Page 8, Lines 11-16). Both the first and second portions are firm enough to support one another in the container, (Page 2, Lines 6-7; Figures 1-2 with first and second portions **16** and **18**, where portion **18** is molded in as central portion running down through the length of the product, forming a "stripe" that is visible across the exposed application surface **14**). These specific elements are also set forth in appealed independent Claim 16.

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

Claim Rejections - 35 U.S.C. § 102

Whether Claims 1, 5, 7, 9, and 11 are anticipated by Banowski et al. (WO 99/23998 as translated by US 6,569,438); and,

Claim Rejections - 35 U.S.C. § 103(a)

Whether Claims 8, 13, 16, 20, 21, 61, 63, 66, and 67 are unpatentable over Banowski (WO 99/23998 as translated by US 6,569,438) as applied to Claims 1, 5, 7, 9, and 11 in view of Swaile et al. (US 5,968,489).

VIII. ARGUMENTS

A. Claims 1, 5, 7, 9, and 11 are not anticipated by WO 99/23998; US 6,569,438 (Banowski, et al.) because Banowski fails to point out each element of Applicant's invention:

Appellant argues that in accordance with 35 U.S.C. §102, Applicant's Claims 1, 5, 7, 9 and 11 *are patentable* because each element of Applicant's claimed invention, recited in Claims 1, 5, 7, 9 and 11, is not described or patented in Banowski. Applicant argues these grounds for Claims 1, 5, 7, 9, and 11 as a group.

In accordance with 35 U.S.C. §102, a person *shall* be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Applicant's independent Claim 1 reads: A product for underarm application, the product including an application surface that contacts the underarm during use of the product, the product comprising: a container; and, a first product portion having a first composition and a second product portion having a second composition · · · wherein both the first composition and the second composition comprise an antiperspirant salt *suspended in an anhydrous, hydrophobic vehicle* including one or both of a volatile silicone and a wax having a melting temperature of at least 70 degrees C, and both the first composition and the second composition form part of the application surface. (Emphasis added for discussion below).

Banowski does not teach that each separate portion (or "phase" as it's called in Banowski) of the composition be *anhydrous and hydrophobic*. Indeed, Banowski teaches

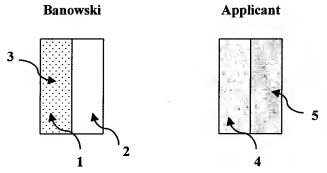
use of very high levels of hydrophilic materials including water, ethanol, glycerin and propylene glycol in various combinations as disclosed in: Column 1, Lines 51-53; Column 2, Lines 6-7, and 9; Column 4, Lines 18-21; Column 4, Lines 45-48; and as specifically seen in each of Banowski's Examples K1-K19, and H1-H15; and Claims 1(a), 3(a), and 8(a). For examples that emphasize the hydrophilic nature of Banowski's compositions, see Example H9 (Column 9) containing 10% water and 50% ethanol, and Example H6 (Column 8) containing 50% ethanol and 34.9% propylene glycol.

Banowski's patent concerns the formulation of multi-phase underarm stick preparations having consumer acceptable feel on the skin, where the individual phases do not "bleed" into one another. Banowski accomplishes this goal by suspending spherical polymer particles having a smooth, slick feel in at least one of the gel phases. Importantly, the Banowski compositions require substantially *hydrophilic matrices* such that the spherical polymer particles can be suspended in the gelled matrix without dissolving. Hence, the examples in Banowski comprise gelled hydrophilic portions created with very large amounts of water, ethanol, glycerin and/or propylene glycol in various combinations. Nowhere in Banowski are *anhydrous hydrophobic* phases disclosed or claimed. Applicant on the other hand uses hydrophobic phases comprised of hydrophobic silicones and/or waxes to achieve smooth skin feel and to prevent bleeding between portions that stand solidified and adjacent to one another in the container.

As depicted in **FIGURE 1** below for clarity, Banowski's invention is a multi-portion product with substantially *hydrophilic* matrices (1 and 2) wherein spherical polymer particles (3) are suspended in at least one of the gelled hydrophilic portions. Applicant's invention is a multi-portion product with *anhydrous hydrophobic* matrices (4

and 5) where silicones and/or waxes are present in each portion and each portion is devoid of water.

FIGURE 1



Applicant's argument regarding Claim 1 applies equally to Claims 5 and 7 that are dependent on Claim 1. Similarly, Applicant's Independent Claim 9 recites the same limitation of *anhydrous hydrophobic vehicle* that is not disclosed in Banowski. Thus, these multiple claims are argued together by Applicant as a group, with Applicant's assertion of patentability over Banowski.

Based on grounds that Banowski fails to point out and disclose all of the elements of Applicant's invention, in particular the element of *anhydrous hydrophobic vehicle*, Applicant respectfully asserts that Claims 1, 5, 7, 9, and 11 are indeed patentable over Banowski.

B. *Banowski et al* (WO 99/23998; US 6,569,438) and *Swaile* (US 5,968,489) do not enable a person of ordinary skill to make Applicant's invention:

Appellant asserts that Banowski et al, (WO 99/23998; US 6,569,438), and Swaile et al, (US 5,968,489), do not qualify as enabling prior art (combined or otherwise) and thus do not render obvious Applicant's pending independent Claims 1, 9, and 16, or dependent Claims 5, 7, 8, 11, 13, 20, 21, 61, 63, 66, and 67. Importantly, although Examiner makes specific obviousness rejection of Claims 8, 13, 16, 20, 21, 61, 63, 66, and 67 as being unpatentable over Banowski "as applied to Claims 1, 5, 7, 9, and 11 in view of Swaile", all of Applicant's pending dependent claims will necessarily stand or fall with the patentability of independent Claims 1, 9, and 16. Thus Applicant argues Claims 1, 5, 7-9, 11, 13, 16, 20, 21, 61, 63, 66, and 67 as a group. To traverse this present, (and previous), obviousness rejections, Applicant has consistently maintained that it is not obvious to take Banowski's gelled hydrophilic compositions and simply substitute silicones or waxes found in Swaile to arrive at Applicant's invention, because Applicant's invention claimed in Claims 1, 9, and 16 are made using Applicant's proprietary method disclosed in the now issued U.S. Patent No. 6,838,032 (filed by Applicant on the same day as this application under appeal).

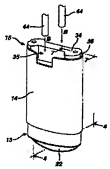
PTO Docket No.: PTO-P-2007-0031, ("Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc."), Section V states, "Office Personnel should consider all rebuttal evidence that is timely presented by the applicants when reevaluating any obviousness determination", including for example, in the case of a claim to a combination the argument that, (1) *"one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological*

difficulties)", (emphasis added). Thus, when a prima facie case of obviousness is deemed made on similarity to a known composition, rebuttal may take the form of evidence that the prior art does not enable the claimed subject matter. "The absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds", *In re Hoeksema*, 399 F.2d 269, 274 (C.A.F.C. 1968). Applicant argues that it is not obvious to make an antiperspirant product having side-by-side anhydrous hydrophobic portions containing silicones and/or waxes because the prior art does not teach, nor had access to, Applicant's proprietary method of manufacturing (now described in U.S. 6,838,032), which is required to make Applicant's invention described in the present application.

Since some of the prosecution history of this application is confusing, a brief comparison of Applicant's and Banowski's inventions and their respective methods of manufacturing are warranted. Recall from Applicant's discussion above (Section A, and particularly **FIGURE 1**) that both Banowski's and Applicant's inventions are essentially multiple-portion underarm antiperspirant compositions cast within their dispensing containers. (For simplicity of discussion, **FIGURE 1** above shows embodiments with only two portions in side-by-side arrangement). As discussed above, Applicant's portions are anhydrous and hydrophobic and comprise silicone, a wax, or both. The goal of Applicant's invention is to provide a soft-feeling multiple-portion underarm antiperspirant product. To achieve this goal, Applicant has used substantial amounts of volatile silicone fluids and/or waxes in most of the disclosed embodiments, (see present application; Example 1, pg. 12; Example 3, pg. 15; Example 4, pg. 16; and, Example 5, pg. 18). The use of volatile silicone fluids (such as Dow Corning DC 245 Fluid) at these

levels in a hydrophobic matrix will necessarily result in soft "semi-solid" phases, even though once cast, the compositions may appear solid and firm within the container. That being said, Applicant's portions need to be cast into the dispensing container using the method described in U.S. 6,838,032, wherein metal dividers are inserted down into the container and the two (or more) portions are injected into the recesses formed between the dividers and bounded by the container. The metal dividers are cooled and pulled out of the container, leaving behind a multi-portion product where stripes or cores are positioned side by side within the container, (see **FIGURE 2** below, from Applicant's '032 patent):

FIGURE 2



Banowski, on the other hand, (in '438 at Column 4, Line 60 through Column 5, Line 13), describes two methods for preparing a two-portion antiperspirant product. According to the first method, a core is produced by pouring a hot hydrophilic liquid phase containing a gellant into a mold and allowing it to cool and gel. The core is then placed inside a wider mold, and then a second hot hydrophilic liquid with gelling agent is then poured into the space inside the mold that surround the core. The second hot liquid is then cooled and gelled to form a shell that surround the core. According to Banowski's

second method, the shell portion is prepared first by casting the heated liquid in an annular mold with a removable cylindrical core piece. After the shell cools and forms a gel, the core piece is removed. The second hot liquid is then poured into the cylindrical cavity of the shell, and is thereafter allowed to cool and gel. Had Banowski thought it obvious to incorporate high levels of volatile silicone such as DC 245 Fluid (by necessarily eliminating their use of water and ethanol to convert their base compositions from hydrophilic to hydrophobic), either of the two methods used by Banowski would fail to produce a multi-portion product within a container. Applicant's anhydrous, hydrophobic portions comprising large amounts of DC 245 Fluid are too soft and too easily re-melted to allow any single portion to be cast first in the container and then used as partial support for the casting of the second portion. The hot melted second portion would necessarily melt the already cast first portion. As discussed, anhydrous hydrophobic compositions with substantial levels of silicone fluid such as DC 245 Fluid must be cast in a container having chilled divider blades inserted therein to provide the side-by-side recesses for the separate hot mixtures.

Applicant stresses that the above discussion is <u>not</u> an argument in support of any "product-by-process" claims, particularly since Applicant does not have any "product-by-process" claims in the present application. Applicant's argument is that the prior art references, taken individually or combined, do not enable Applicant's invention. It was not obvious for Banowski to completely alter their high water, high alcohol, gelled compositions into Applicant's anhydrous, hydrophobic compositions with significant levels of silicones because the portions ***<u>couldn't be molded sequentially as described by Banowski</u>***.

IX. CONCLUSION OF ARGUMENTS

In view of the foregoing, Appellant submits that the rejection of Claims 1, 5, 7, 9, and 11 under 35 U.S.C. § 102, and rejection of Claims 8, 13, 16, 20, 21, 61, 63, 66, and 67 under 35 U.S.C. § 103 are improper and should not be sustained. Therefore, a reversal of the rejections in the Office action dated June 25, 2008 is respectfully requested.

Respectfully submitted,

Dated 11/11/08

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X. CLAIMS APPENDIX

Claims on Appeal

1. A product for underarm application, the product including an application surface that contacts the underarm during use of the product, the product comprising

a container, and

a first product portion having a first composition and a second product portion having a second composition, wherein one portion is firmer than, and provides support for, the other portion, wherein both the first composition and the second composition comprise an antiperspirant salt suspended in an anhydrous, hydrophobic vehicle including one or both of a volatile silicone and a wax having a melting temperature of at least 70 degrees C, and both the first composition and the second composition form part of the application surface.

5. The product of claim 1, wherein the second portion is in the form of a lengthwise-extending stripe extending approximately from a first end of the application surface to a second end of the application surface.

7. The product of claim 1, wherein the first portion and the second portion each independently comprise at least 15% of the application surface.

8. The product of claim 1, wherein both the first composition and the second composition further comprise up to 10% by weight hydrophilic vehicle.

9. A product for underarm application, the product including an application surface that contacts the underarm during use of the product, the product comprising

a container, and

a first product portion having a first composition and a second product portion having a second composition, wherein one portion is different in color and firmer than, and provides support for, the other portion, wherein both the first composition and the second composition comprise an antiperspirant salt suspended in an anhydrous, hydrophobic vehicle including one or both of a volatile silicone and a wax having a melting temperature of at least 70 degrees C, and both the first composition and the second composition form part of the application surface.

11. The product of claim 9, wherein either the first composition or the second composition is in the form of a lengthwise-extending stripe extending approximately from a first end of the application surface to a second end of the application surface.

13. The product of claim 9, wherein both the first composition and the second composition further comprise up to 10% by weight hydrophilic vehicle.

16. A product for underarm application, the product including an application surface that contacts the underarm during use of the product, the product comprising

a container, and

a first product portion having a first composition and a second product portion having a second composition, wherein one portion is different in color and firmer than, and provides support for, the other portion, wherein the first composition comprises more than 6 USP weight percent of an antiperspirant salt suspended in an anhydrous, hydrophobic vehicle including one or both of a volatile silicone and a wax having a melting temperature of at least 70 degrees C and the second composition comprises less than 6 USP weight percent of an antiperspirant salt suspended in an anhydrous, hydrophobic vehicle including one or both of a volatile silicone and a wax having a melting temperature of at least 70 degrees C, the application surface consisting of the first composition and the second composition.

20. The product of claim 16, wherein the first composition or the second composition is in the form of a lengthwise-extending stripe extending approximately from a first end of the application surface to a second end of the application surface.

21. The product of claim 16, wherein the first composition comprises from at least 6 USP weight percent to 25 USP weight percent of the antiperspirant salt and the second portion

comprises from at least 3 USP weight percent to 6 USP weight percent of the antiperspirant salt.

61. The product of claim 8, wherein the hydrophilic vehicle comprises a polyhydric alcohol.

63. The product of claim 13, wherein the hydrophilic vehicle comprises a polyhydric alcohol.

66. The product of claim 16, wherein both the first composition and the second composition further comprise up to 10 weight percent hydrophilic vehicle.

67. The product of claim 66, wherein the hydrophilic vehicle comprises a polyhydric alcohol.

XI. EVIDENCE APPENDIX

There is no evidence relied upon by the Applicant in the present appeal.

XII. RELATED PROCEEDINGS APPENDIX

As there are no related appeals and interferences, there are also no decisions rendered by a court or the Board of Patent Appeals and Interferences that are related to the instant appeal.